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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/763,897  | 01/23/2004  | Soichi Wakatsuki     | MITPA10.001AUS      | 7774             |
| 76993 7590 04/03/2009<br>Law Office of Katsuhiro Arai<br>22471 Aspan Street<br>Suite 205 C<br>Lake Forest, CA 92630 |             |                      |                     |                  |
| EXAMINER  |             |                      |                     |                  |
| MUI, CHRISTINE T  |             |                      |                     |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
| 1797  |             |                      |                     |                  |
| NOTIFICATION DATE   |             | DELIVERY MODE        |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

KAPAT@KAPATLAW.COM

### Office Action Summary

**Application No.**

10/763,897

**Applicant(s)**

WAKATSUKI ET AL.

**Examiner**

CHRISTINE T. MUI

**Art Unit**

1797

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10, 11 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10, 11 and 18-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments filed 31 December 2008 have been fully considered but they are not persuasive.
2. In response to the applicant's argument, as to the references being silent as to capturing the crystal, Examiner respectfully disagrees. Kiefersauer discloses a holding device for particulate matter. Examiner believes that in holding particulate matter, one needs to first capture the particulate matter. Merriam-Webster discloses the meaning of capturing as 'to gain control of especially by force'. Examiner believes that in holding something, one needs to capture first.
3. In response to applicant's arguments, the recitation 'in a loop using the surface tension of a liquid surrounding the micro crystal' has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).
4. In response to the applicant's assertion that neither Tanikawa nor Kiefersauer teaches or even suggests the step of "placing on a base a liquid droplet in which micro-crystals are dispersed, said droplet having a dome-shaped surface due to the surface tension of the droplet;" examiner respectfully disagrees. It is inherent property of a

droplet is to be dome-shaped. Furthermore, Kiefersauer discloses the protein crystals that are held are surrounded by a drop of protective solution picked up by the wire or plastic loop (see column 8, lines 12-21).

5. In response to the argument that neither Tanikawa nor Kiefersauer teaches or suggests inserting and using their device in liquid, the Examiner respectfully disagrees. Kiefersauer discloses the device for holding a particular material samples with high fluid content (see column 2, lines 8-14). Merriam-Webster defines a fluid as a substance (as a liquid or gas).

6. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Kiefersauer discloses the holding or capturing member and Tanikawa discloses the gripping means. It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the loop in and gripping means of the references cited so that upon the event of capturing the crystal in solution or droplet, one is able to obtain a firm and secure grip on the crystals for examination.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 10, 11 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 5,651,574 to Tanikawa (herein referred 'Tanikawa'), and further in view of USP 6,355,217 to Kiefersauer et al (herein referred 'Kiefersauer').

11. Regarding claims 10-11, the reference Tanikawa discloses a micromanipulator with an upper parallel linkage connecting a base member and an opposed middle plate by links, a lower parallel linkage connecting the middle plate and an opposed base plate by links, a first finger attached to the base member of the upper parallel linkage, a second finger attached to the middle plate and is arranged opposite the first finger and drive controllers for effecting relative motions of the fingers in manipulating an object(see abstract). Tanikawa does not disclose a trapping means that comprises a trapping loop for trapping crystals gripped by the gripping means. It is interpreted by the examiner that the gripping means are able to be inserted into a droplet to manipulate an object such as a crystal for examination. Kiefersauer discloses a holding device for particulate material samples that features a carrier block for a loop holder that has a free mounting end for a particular sample, such as ones known from protein crystallography or cryotransferring of samples. The holding device is for particulate material samples especially a sample holder for particles with high fluid content like protein crystals. When obtaining crystal samples from protein crystals, the loop is passed back and forth over the tip so that at least some of the solution is retained in the crystal. According to the device of the holding device, if it is used to mount particles of organic molecules, substances with a high water content, sacchariferous substances, hydrated or dehydrated substances or polymer polysaccharides, the size of the capillary may be adapted accordingly. It is interpreted by the examiner that if the capillary may be adapted to mount particles, the loop may also be adapted to change to properly trap crystals of different sizes by inserting the loop into the droplet for capturing the micro-

crystal once the top layer of the droplet is removed and place where particles are examined and crystals are extracted from the droplet are placed upon a surface that is a base for examination where it can be displayed and observed. Furthermore, the holding device is not restricted to just use with a vacuum tweezers when a capillary is used but can be also used with other holder devices in which the particulate material sample adheres to the tip of the holding capillary or loop through the effect of holder devices in which the particulate material sample adheres to the tip of the holding capillary through the effect of adsorptive forces, electrical forces or adhesive (see abstract, column 1, lines 5-8, column 2, lines 7-21, 41-67, column 6, line 61-column 7, line 44). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a trapping loop in conjunction with the micromanipulator with fingers in obtaining crystals from a solution so that the crystals can be isolated and properly removed and analyzed without the possibility of contamination from human touch and an ejection device for ejecting droplets of liquid in a particular location for examination.

12. Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanikawa and Kiefersauer as applied to claim 10 above.

13. Regarding claims 18-19, the references Tanikawa and Kiefersauer disclose the claimed invention except for specifically gripping the upper side of the loop at the step of inserting the loop. It would have been obvious to one having ordinary skill in the art at the time the invention was made, as a matter of design choice to grip the micro-crystal

on the upper side of the loop so that the user or robot can trap the crystal for analysis while the gripping means has gripped the micro-crystal to stabilize its location.

14. Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanikawa and Kiefersauer as applied to claim 10 above.

Regarding claims 20-21, the references Tanikawa and Kiefersauer disclose the claimed invention except for there is a specific step of separating the gripping member and the loop by lowering the base. It would have been obvious to one having ordinary skill in the art at the time the invention was made to separate the loop and the gripping means from each other after grasping the micro-crystal for examination by lowering the base where the droplet was initially placed and not lifting the loop and gripping means so the risk of moving the micro-crystal is minimized and the possibility of dropping the crystal is eliminated.

### ***Conclusion***

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of



the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTINE T. MUI whose telephone number is (571)270-3243. The examiner can normally be reached on Monday-Thursday 7-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter Griffin can be reached on (571) 272-1447. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CTM

/Walter D. Griffin/  
Supervisory Patent Examiner, Art Unit 1797